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10/076,211	02/12/2002	Paul Trpkovski	44046.103.203.21.2	9015

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EXAMINER

A, PHI DIEU TRAN

ART UNIT PAPER NUMBER

3637

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/076,211

Applicant(s)

TRPKOVSKI, PAUL

Examiner

Phi D A

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 August 2004.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,6,8-12,48-51 and 55-62 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1,6,8-12,48-51,55-62 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

With respect to the limitation of "glazing compound" in claims 1, 6, 8-12, the limitation is not claimed and is thus treated accordingly as a subcombination with the other claimed structures.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 6, 12, 61 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Eckart Jr. (3837949) and Tachauer (2003/0070391).

Adams Jr. et al shows a transparent window pane (18) having first and second generally opposed major surfaces (20, 21) being sized and shaped to be mounted in a frame configured to received at least one edge of the pane (figures 5b, 6b), the pane having a removable protective covering (22) disposed over a central portion of the first surface and that extend across a length of the first surface or across a width of said surface, the central portion spanning at least 70% of the first surface, the first surface having an unmasked peripheral apron, the masking material being a transparent film (col 3 line 45), the unmasked apron extends between an outer periphery of the protective covering and an outer periphery of the pane, the covering being attached to the first major surface by masking adhesive (inherently being masking adhesive as the adhesive is made to be removed with the masking cover), the masking material being translucent or transparent (col 3 lines 44-45).

Adams Jr. et al does not show the protective covering having a plurality of strips of masking material that are disposed over a central portion of the first surface, the strips of masking material being disposed in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip, the strips extending substantially in parallel across the first surface of the pane, the strips being adhesively attached to the first major surface by a masking adhesive, the overlapped strips of masking film defining a plurality of exposed lateral edges that form readily accessible means, the strips are affixed to one another by adhesive.

Tachauer shows sequentially overlapping strips covering a large central portion of a first surface of a structure.

Eckart Jr. discloses a protective covering having a plurality of strips of masking material, the strips being affixed to one another by adhesive, the strips extending substantially parallel across the first surface of the pane, the strips defining a plurality of exposed lateral edges.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the protective covering having a plurality of strips of masking material that are disposed over a central portion of the first surface, the strips of masking material being disposed in a sequentially overlapping fashion with each subsequent strip overlapping a portion of a preceding strip as taught by Tachauer, the strips extending substantially in parallel across the first surface of the pane, the strips being adhesively attached to the first major surface by a masking adhesive, the overlapped strips of masking film defining a plurality of exposed lateral edges that form readily accessible means, the strips are affixed to one another by adhesive as taught by Eckart Jr. because having the multiple strips of masking material disposed over a large central portion of a first surface would protect the central portion

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of the structure from external damaging forces as taught by Tachauer, and having the strips extending substantially in parallel across the first surface of the pane, the strips being adhesively attached to the first major surface by a masking adhesive, the overlapped strips of masking film defining a plurality of exposed lateral edges that form readily accessible means, the strips affixed to one another by adhesive would result in the easy covering of the glass pane for a paint job and removal of the masked material from the window pane when the paint job is done as taught by Eckart Jr.

3. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Eckart Jr. (3837949) and Tachauer (2003/0070391) as applied to claimed 1 above and further in view of Smith et al (5735089).

Adams Jr. et al as modified shows all the claimed limitations except for the covering being sized, shaped, and positioned such that at least one/all peripheral side portion of the covering extending significantly beneath a confronting surface of the frame when the pane is mounted, the peripheral side portions of the covering does not extend so far beneath the confronting surface of the frame as to engage glazing compound between the frame and the pane.

Smith et al discloses covering (14) being sized, shaped, and positioned such that at least one/all peripheral side portion of the covering extending significantly beneath a confronting surface of the frame when the pane is mounted, the peripheral side portions of the covering does not extend so far beneath the confronting surface of the frame as to engage any glazing compound between the frame and the pane, the edges being hidden in grooves.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to show the covering being sized,

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shaped, and positioned such that at least one/all peripheral side portion of the covering extending significantly beneath a confronting surface of the frame when the pane is mounted, the peripheral side portions of the covering does not extend so far beneath the confronting surface of the frame as to engage glazing compound between the frame and the pane as taught by Smith et al because it would enable Adam Jr. et al's modified cover to hide the edges in the groove and thus reducing the precise manufacturing tolerance required of the cover, which would result in cost saving and guarantee covering of the exposed central portion of the pane.

4. Claims 48-51,55 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Tachauer (2003/0070391), Smith et al (5735089) and Emmanuel (5836119).

Adam Jr. et al shows a glazing assembly having a transparent pane (18) and a frame (26) to which the pane is mounted, the frame receives an edge of the pane, the pane having first and second generally opposed major surfaces (20b, 21b), at least one edge received in the frame, the pane having a protective covering (22b) disposed over a portion of the first surface, the first surface having an unmasked apron (the surface not covered) extending between an outer periphery of the covering an outer periphery of the pane, the covering consisting of a single sheet of masking material, the masking material being a masking film (transparent layer), the pane being part of a multiple pane insulating glass unit (col 1 lines 49-51), the pane being mounted such that all edges of the pane being received in the frame (figure 5b, 6b), the masking material being flexible.

Adams Jr. et al does not show the protective covering comprising a plurality of strips of masking material, at least one piece of the masking material having at least one/all peripheral

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side portion extending significantly beneath a confronting surface of the frame, the side portions extending a predetermined distance beneath the confronting surfaces of the frame, a glazing compound between the pane and the frame.

Tachauer et al discloses a protective covering having a plurality of strips of masking material (figure 4A) to cover a large surface without resorting to one large (large in both dimensions) piece of covering.

Smith et al shows at least one piece of masking material (14) having at least one/all peripheral side portion extending significantly beneath a confronting surface of the frame (33), the side portions extending a predetermined distance beneath the confronting surfaces of the frame, the edges of the covering being inside grooves to hide the edges.

Emmanuel shows a glazing compound (83) connecting the frame and pane together.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adam jr. et al to show the protective covering comprising a plurality of strips of masking material as taught by Tachauer et al, at least one piece of the masking material having at least one/all peripheral side portion extending significantly beneath a confronting surface of the frame, the side portions extending a predetermined distance beneath the confronting surfaces of the frame as taught by Smith et al, a glazing compound between the pane and the frame as taught by Emmanuel because having the covering made of a plurality of strips would enable easy covering of a large area, and the use of multiple smaller strips reduces the manufacturing and transportation cost associated with a large piece of covering, having the at least one/all peripheral side portion extending beneath a confronting surface of the frame would enable Adam Jr. et al's cover to hide the edges in grooves and thus reducing the precise

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manufacturing tolerance required of the cover, which would result in cost saving and guarantee covering of the exposed central portion of the pane, and having a glazing compound within the frame would enhance the securement of the frame to the pane as taught by Emmanuel.

5. Claim 56 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Smith et al (5735089) in view of Emmanuel (5836119), and Tachauer (2003/0070391).

Adams Jr. (figure 2) shows a glazing assembly comprising an insulating glass unit and a frame to which the insulating glass unit is mounted, the unit comprising first and second panes (col 1 lines 14-16, line 51) having an insulating glass unit (12) and a frame (26) to which the insulating glass unit is mounted, the unit having a first pane (21) having generally opposed inner and outer surfaces, the first pane having at least one edge received in the frame, a protective covering (22) is disposed over a portion of the outer surface of the second pane, the outer surface of the second pane having an unmasked apron extending between an outer periphery of the covering and an outer periphery of the second pane, the covering having at least one piece of masking material (22), the masking material being a flexible masking film.

Adam Jr. does not show the covering comprising a plurality of strips of masking material, glazing compound being located between the frame and the outer surface of the first pane but not between the frame and the outer surface of the second pane, the masking material extending beneath a confronting surface of the frame.

Smith et al shows a masking material extending beneath a confronting surface of the frame.

Emmanuel (figure 3) shows a window unit having a first and second pane (46, right and left respectively), glazing compound (83) located between the frame and the outer surface of the first pane (46 right) but not between the frame and the outer surface of the second pane (46, left).

Tachauer discloses a covering member being a plurality of strips of masking material.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the covering comprising a plurality of strips of masking material as taught by Tachauer, glazing compound being located between the frame and the outer surface of the first pane but not between the frame and the outer surface of the second pane as taught by Emmanuel, the masking material extending beneath a confronting surface of the frame as taught by Smith et al because having the cover made of a plurality of strips as taught by Tachauer would enable the covering of a large area with small strips, and thus resulting in cost saving per easy of manufacturing and transporting of the covering material, and having the glazing compound only between the first panel and the frame but not the second pane and the frame would enhance the securing of the first panel to the frame as taught by Emmanuel, and having the masking material extending beneath a confronting surface of the frame would enable the complete coverage and protection of the window panes against external objects as taught by Smith et al.

6. Claims 57-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Smith et al (5735089), Emmanuel (5836119), and Tachauer (2003/0070391) as applied to claim 56 above and further in view of Kupec et al (2672122).

Adams Jr. et al as modified shows all the claimed limitations except for the covering having at least one tab or extension to facilitate removing the covering.

Kupec et al shows a tab (36) attached to the covering to facilitate removing of the covering.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to show the covering having at least one tab or extension to facilitate removing the covering because it would facilitate easy removal of the covering as taught by Kupec et al.

Per claims 59-60, Adams Jr. et al modified by Emmanuel and Kupec et al shows all the claimed limitations except for the distance being at least 1/16 inch and about 1/8 inch.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al's modified structure to show the distance being at least 1/16 inch and about 1/8 inch because it would have been an obvious matter of design choice to show the distance being at least 1/16 inch and about 1/8 inch since such a modification would have involved a mere change in the size of a component/groove. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

7. Claim 62 is rejected under 35 U.S.C. 103(a) as being unpatentable over Adams Jr. (5866260) in view of Smith et al (5735089) in view of Emmanuel (5836119).

Adams Jr. (figure 2) shows a glazing assembly comprising a transparent pane and a frame (26) to which the pane is mounted, the frame being made of wood, the frame receives an edge of the pane, the transparent pane having first and second generally opposed major surfaces, the pane having a protective covering (22) disposed over a portion of the first surface, the first surface having an unmasked apron extending between an outer periphery of the covering and an outer

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periphery of the pane, the covering comprising at least one piece of masking material, the material being a flexible film.

Adam Jr. does not show the covering comprising the wood being vinyl-covered wood or a tubular construction of metal or metal alloy, glazing compound between the frame and the pane, the masking material extending beneath a confronting surface of the frame but does not extend so far beneath the frame as to engage the glazing compound.

Smith et al shows a masking material extending beneath a confronting surface of the frame but does not extend so far beneath the frame as to engage the glazing compound, the frame being made of extruded aluminum.

Emmanuel (figure 3) shows a window unit having glazing compound (83) located between the frame and the pane.

It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Adams Jr. et al to show the glazing compound being located between the frame and the first pane as taught by Emmanuel, the masking material extending beneath a confronting surface of the frame but does not extend so far beneath the frame as to engage the glazing compound, the frame being metal alloy as taught by Smith et al because having the glazing compound only between the panel and the frame would enhance the securing of the panel to the frame as taught by Emmanuel, and having the masking material extending beneath a confronting surface of the frame without touching the glazing compound would enable the complete coverage and protection of the window panes against external objects as taught by Smith et al, and having the frame made of metal alloy as taught by Smith et al would form a strong supporting frame for a window.

Response to Arguments

8. Applicant's arguments with respect to claims 1, 6, 8-12, 48-51, 55-62 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a).

Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phi D A whose telephone number is 703-306-9136. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lanna Mai can be reached on 703-308-2486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Phi Dieu Tran A *PA*

11/15/04

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